

Attorney Docket No.: DEX-0113
Inventors: Yang et al.
Serial No.: 10/700,770
Filing Date: January 16, 2001
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REMARKS

Claims 1 and 9-13 are pending in the instant application. Claims 14-18 have been added. Support for new claims 14-16 can be found in claim 1 as originally filed. Support for new claims 17-18 can be found in the specification at page 12 lines 11 through 15.

Claims 9-13 are allowed.

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Bandman et al. The Examiner suggests that Bandman's teachings that "relatively high amounts of transcript in biopsied tissue from an individual may indicate a predisposition for the development of disease" renders obvious Applicants' claim specifying that expression levels must be at least two times higher to be diagnostic for lung cancer because one of skill in the art would reasonably interpret "relatively high amounts" as those levels that are at least 2 times higher than normal or even 10 times higher than normal. The Examiner cites In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA) 1976) and In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Circ. 1990) in support of this rejection suggesting that there is "an overlap in range" between Bandman which teaches the "range of relatively high" and the instant claims which require expression levels of a least two times higher.

Applicants respectfully disagree with the Examiner's assertion that the vague teachings of Bandman that "relatively high amounts of transcript in a biopsied tissue from an individual may indicate a predisposition for development of disease" anticipates or constitutes a range within which the explicit teachings of the instant specification falls, with respect to detecting lung cancer.

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However, in an earnest effort to advance the prosecution of this case, Applicants have canceled claim 1 without prejudice.

Withdrawal of this rejection under 35 U.S.C. § 103(a) and allowance of pending claims 9-13 is respectfully requested.

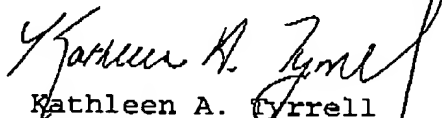
Electronically filed IDS

Applicants submitted electronically two Supplemental Information Disclosure Statements on October 27, 2004 but to date have not received copies initialed by the Examiner indicative of his receipt and review. It is therefore respectfully requested that the Examiner forward acknowledgment of receipt of these electronically filed Information Disclosure Statements in the form of a copy of these Information Disclosure Statements initialed and dated by the Examiner.

Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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